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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,294	05/23/2000	Andreas Bleckmann	BEIERSDORF 614-WCG	3516

7590 10/17/2002

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New York, NY 10017

EXAMINER
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WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/17/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/577,294

Applicant(s)

BLECKMANN ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/26/02, 2/28/02 and 4/26/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The Amendment filed 2/26/02, Paper No. 13, amended claim 6. The Amendment filed 2/28/02, Paper No. 14, amended claim 1.

### ***Continued Prosecution Application***

The request filed on 4/26/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/577294 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Election/Restrictions***

Applicant's election with traverse of a w/o emulsion comprising water, water soluble substances, lipids, interface-active substances, and cationic polymers, in Paper No. 19 is acknowledged. The traversal is on the ground(s) that any search of the claimed invention with respect to any species could easily include a search of the full scope of the claimed invention. This is not found persuasive. In the instant independent claim, Applicant has claimed a w/o emulsion comprising water, optionally a water soluble-substance, lipids, alkyldimethicone or alkylmethicone copolyols. The Examiner respectfully points out that searching every possible water-soluble substance, every possible lipid, and every possible combination thereof, would place a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's elected species' were searched. The search was not extended because prior art was found to render the species' obvious.

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### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-12 of copending Application No. 09/328,727; over claims 1-5 of copending Application No. 09/693,161; over claims 1-6 and 8 of copending Application No. 09/428,421. Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant invention and '727, '161, and '421 are all directed to water-in-oil emulsions comprising at least 75% of an aqueous phase, a lipid phase, and a surfactant selected from alkylmethicone copolyols, alkyl dimethicone copolyols, and mixtures thereof. While '727, '161, and '421 do not teach the exact same amounts of lipids, aqueous phase constituents, and surfactants, or teach viscosities, it would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the

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w/o emulsions of '727, '161 and '421 as comprising the percent weights of the constituents in the instant application because it has been held that where the general conditions of a claim are disclosed, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-8, 10-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 1 is vague and indefinite, as it is confusing. Regarding part (a), are lipids and lipophilic constituents synonymous or are they distinct entities? Is the total weight of the preparations referring to the total weight of the emulsions? Regarding part (b), is it referring the "lipids" and "lipophilic constituents" of part (a)?

(ii) The phrase "(butyldecanol+. . .+butyloctanol)" in claim 4 (line 3) is vague and indefinite, as it is not clear if the information within the parenthesis is intended to be claimed and it is further unclear what relationship exists between the compounds listed within the parenthesis.

(iii) Claims 4-8, 10-11 are vague and indefinite, as it is not clear whether the percent weights refer to the emulsions as a whole, to the aqueous phase, or to something else.

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(iv) The term “derivatives” in claim 6 (lines 2, 8) is vague and indefinite, as it is not clear what compounds are encompassed by this phrase. The specification does not further define this phrase and one of ordinary skill in the art would not be apprised of all the chemical compounds encompassed by this phrase.

(v) The phrase “condensation products of polyglycols and amines” in claim 6 (line 4) is vague and indefinite, as it is not clear to what compounds/chemical constituents this phrase refers. The specification does not definitely define the phrase and one of ordinary skill in the art would not be apprised of its meaning.

(vi) The term “cationic biopolymers” in claim 6 (last line) is vague and indefinite, as it is not clear what polymers are encompassed by this phrase. The specification does not definitely define the term and one of ordinary skill in the art would not be apprised of all the polymers encompassed by this phrase.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. (6,153,204).

Fanger et al. teach sunscreens having ultraspectral protection. Exemplified is a water-in-oil emulsion comprising 1.5% laurylmethicone copolyol, 0.5% cetylmethicone copolyol, 4% capric/caprylic triglycerides, 4% glycerol, and water, wherein the water phase comprises 76% of

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the composition. Caprylic/capric triglyceride and dicaprylyl ether are disclosed as interchangeable oil phase constituents. The reference lacks an exemplification and viscosity parameters. See Col. 2, lines 32-34; Col. 4, line 53-Col. 5, line 2; Col. 8, line 1-Col. 12, line 30.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute dicaprylyl ether for caprylic/capric triglyceride in example 6 of the reference because Fanger et al. teach caprylic/capric triglyceride and dicaprylyl ether as interchangeable oil phase constituents in their emulsions. It is noted that the viscosity parameters must be met if all the limitations of the composition are met.

Claims 1-2, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. in view of Mahieu et al. (5,616,746) and Philippe et al. (2002/0064539).

Fanger et al. is applied as discussed above. The reference lacks the water phase comprising greater than 80% of the emulsion.

Mahieu et al. teach cosmetic compositions of the water-in-oil type, wherein the aqueous phase can comprise 30-85% of the composition. Specifically exemplified is a water-in-oil emulsion comprising cetyldimethicone copolyol and glycerine. See Col. 4, line 30-line 67; Col. 13, line 54-Col. 14, line 3.

Philippe et al. teach cosmetic or dermatological compositions in the form of skincare products, make-up products, or antisen products. Water in oil emulsions, wherein the aqueous phase comprises 50-98.9% of the emulsion, are disclosed. See [0091]-[0096]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the emulsion of Fanger et al. as comprising greater than 80% of the aqueous phase because Philippe et al. teach that water-in-oil emulsions, wherein the aqueous phase

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comprises greater than 80% are known and useful in the cosmetic art, and Mahieu et al. specifically teach water-in-oil emulsions comprising cetyldimethicone copolyol and glycerine as having aqueous phases comprising 85% of the emulsions.

Claims 1, 5, 6, 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. in view of Albacarys et al. (6,338,855).

Fanger et al. is applied as discussed above. The reference lacks cationic polymers.

Albacarys et al. teach cleansing articles for skin and/or hair. Disclosed are water in oil emulsions that can comprise conditioning agents, such as chitosan salts. The conditioning agent is disclosed as comprising preferably 1-25% of a composition. See Col. 26, line 19-Col. 42, line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the chitosan salts of Albacarys et al. to the emulsion of Fanger et al. because Fanger et al. teach that moisturizers, which are synonymous to conditioning agents, can be added to their compositions, and Albacarys et al. teach their conditioning components as improving the appearance and/or feel of mammalian skin upon/after topical application.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for



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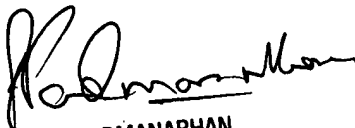
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the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
September 10, 2002

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

10/14/02